

Please type a plus sign (+) inside this box → [X]

PTO/SB/05 (11/00)

Approved for use through 10/31/2002. OMB 0651-0032

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**UTILITY
PATENT APPLICATION
TRANSMITTAL**

Attorney Docket No. 830010-2002.2
First Inventor Gavril W. Pasternak
Title TOPICAL ANESTHETIC/OPIOID FORMULATIONS AND USES THEREOF
Express Mail Label No. EL861104765US

For new nonprovisional applications under 37 CFR 1.53(b))

APPLICATION ELEMENTS

See MPEP chapter 600 concerning utility patent application contents.

1. ☒ Fee Transmittal Form (e.g., PTO/SB/17)
(Submit an original, and a duplicate for fee processing)
2. ☒ Applicant claims small entity status.
See 37 CFR 1.27.
3. ☒ Specification [Total Pages 29]
(preferred arrangement set forth below)
- Descriptive title of the invention
- Cross References to Related Applications
- Statement Regarding Fed sponsored R & D
- Reference to sequence listing, a table, or a computer program listing appendix.
- Background of the Invention
- Brief Summary of the Invention
- Brief Description of the Drawings (if filed)
- Detailed Description
- Claim(s)
- Abstract of the Disclosure
4. ☒ Drawing(s) (35 U.S.C. 113) [Total Sheets 7]
5. ☒ Oath or Declaration [Total Pages 1]
☐ Newly executed (original or copy)
☒ Copy from a prior application (37 CFR 1.63(d))
(for continuation/divisional with Box 18 completed)
i. ☐ **DELETION OF INVENTOR(S)**
Signed statement attached deleting inventor(s)
named in the prior application, see 37 CFR
1.63(d)(2) and 1.33(b).
6. ☐ Application Data Sheet. See 37 CFR 1.76.

ADDRESS TO: Assistant Commissioner for Patents
Box Patent Application
Washington, DC 20231

7. ☐ CD-ROM or CD-R in duplicate, large table
or Computer Program (Appendix)
8. Nucleotide and/or Amino Acid Sequence Submission
(if applicable, all necessary)
a. ☐ Computer Readable Form (CFR)
b. Specification sequence Listing on:
i. ☐ CD-ROM or CD-R (2 copies); or
ii. ☐ paper
c. ☐ Statements verifying identity of above copies

ACCOMPANYING APPLICATION PARTS

9. ☐ Assignment Papers (cover sheet & documents(s))
10. ☐ 37 CFR 3.73(b) Statement
☒ Power of Attorney
(when there is an assignee)
11. ☐ English Translation Document (if applicable)
12. ☐ Information Disclosure Statement (IDS)/PTO-1449 ☐ Copies of IDS Citations
13. ☒ Preliminary Amendment
14. ☒ Return Receipt Postcard (MPEP 503)
(Should be specifically itemized)
15. ☐ Certified Copy of Priority Document(s)
(if foreign priority is claimed)
16. ☐ Request and Certification under 35 U.S.C. 122(b)(2)(B)(i).
Applicant must attach from PTO/SB/35 or its equivalent.
17. ☐ Other:

18. If a CONTINUING APPLICATION, check appropriate box, and supply the requisite information below and in a preliminary amendment, or in an Application Data Sheet under 37 CFR 1.76:

☐ Continuation ☒ Divisional ☐ Continuation-in-part (CIP) of prior application No.: 09/844,111
Prior application information: Examiner: M. Bahar Group/Art Unit: 1614

For CONTINUATION OR DIVISIONAL APPS only: The entire disclosure of the prior application, from which an oath or declaration is supplied under Box 5b, is considered a part of the disclosure of the accompanying continuation or divisional application and is hereby incorporated by reference. The incorporation can only be relied upon when a portion has been inadvertently omitted from the submitted application parts.

19. CORRESPONDENCE ADDRESS

☒ Customer Number or Bar Code Label (Insert Customer No. or Attach bar code label here) or ☐ Correspondence address below
Name

Name (Print/Type)	Susan K. Lehnhardt	Registration No. (Attorney/Agent)	33,943
Signature	<i>Susan Lehnhardt</i>	Date	October 11, 2001

Under the Paperwork Reduction Act of 1965, no persons are required to respond to a collection of information unless it displays a valid OMB control number

<h1 style="margin: 0;">FEE TRANSMITTAL</h1> <h2 style="margin: 0;">for FY 2001</h2> <p style="margin: 0;">Patent fees are subject to annual revision.</p>		Complete if Known	
		Application Number	TO BE ASSIGNED
		Filing Date	CONCURRENT
		First Named Inventor	PASTERNAK, ET AL.
		Examiner Name	TO BE ASSIGNED
TOTAL AMOUNT OF PAYMENT	(\$) 505.00	Group/Art Unit	TO BE ASSIGNED
		Attorney Docket No.	830010-2002.2

<h3 style="text-align: center;">METHOD OF PAYMENT</h3> <p>1. <input type="checkbox"/> The Commissioner is hereby authorized to charge indicated fees and credit any over payments to:</p> <table border="1" style="width: 100%; margin-top: 10px;"> <tr> <td style="width: 50%;">Deposit Account Name</td> <td style="width: 50%; text-align: center;">Frommer Lawrence & Haug LLP</td> </tr> <tr> <td>Deposit Account Number</td> <td style="text-align: center;">50-0320</td> </tr> </table> <p><input checked="" type="checkbox"/> Charge any Additional Fee Required Under 37 CFR 1.16 and 1.17 <input type="checkbox"/> Charge the Issue Fee Set in 37 CFR 1.18 at the Mailing of the Notice of Allowance</p> <p>2. <input checked="" type="checkbox"/> Payment Enclosed <input checked="" type="checkbox"/> Check <input type="checkbox"/> Money Order <input type="checkbox"/> Other</p> <h3 style="text-align: center;">FEE CALCULATION</h3> <h4>1. BASIC FILING FEE</h4> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Fee Code</th> <th>Entity Fee (\$)</th> <th>Small Fee Code</th> <th>Entity Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>101</td><td>740</td><td>201</td><td>370</td><td>Utility filing fee</td><td style="text-align: right;">\$370.00</td></tr> <tr><td>106</td><td>330</td><td>206</td><td>165</td><td>Design filing fee</td><td></td></tr> <tr><td>107</td><td>510</td><td>207</td><td>255</td><td>Plant filing fee</td><td></td></tr> <tr><td>108</td><td>740</td><td>208</td><td>370</td><td>Reissue filing fee</td><td></td></tr> <tr><td>114</td><td>160</td><td>214</td><td>80</td><td>Provisional filing fee</td><td></td></tr> <tr> <td colspan="5" style="text-align: right;">SUBTOTAL (1)</td> <td style="text-align: right;">\$370.00</td> </tr> </tbody> </table> <h4>2. EXTRA CLAIM FEES</h4> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td>Total Claims</td> <td style="text-align: center;">35</td> <td>-20** =</td> <td style="text-align: center;">15</td> <td>X</td> <td style="text-align: center;">135.00</td> <td>=</td> <td style="text-align: center;">135.00</td> </tr> <tr> <td>Ind. Claims</td> <td></td> <td>-3** =</td> <td></td> <td>X</td> <td></td> <td>=</td> <td></td> </tr> <tr> <td>Multiple Dependent</td> <td></td> <td></td> <td></td> <td>X</td> <td></td> <td>=</td> <td></td> </tr> </table> <p style="font-size: small;">** or number previously paid, if greater; for reissues, see below</p> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Fee Code</th> <th>Entity Fee (\$)</th> <th>Small Fee Code</th> <th>Entity Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>103</td><td>18</td><td>203</td><td>9</td><td>Claims in excess of 20</td><td></td></tr> <tr><td>102</td><td>84</td><td>202</td><td>42</td><td>Independent claims in excess of 3</td><td></td></tr> <tr><td>104</td><td>280</td><td>204</td><td>140</td><td>Multiple dependent claim, if not paid</td><td></td></tr> <tr><td>109</td><td>84</td><td>209</td><td>42</td><td>** Reissue independent claims over original patent</td><td></td></tr> <tr><td>110</td><td>18</td><td>210</td><td>9</td><td>** Reissue claims in excess of 20 and over original patent</td><td></td></tr> <tr><td>107</td><td>510</td><td>207</td><td>255</td><td>Plant filing fee</td><td></td></tr> <tr> <td colspan="5" style="text-align: right;">SUBTOTAL (2)</td> <td style="text-align: right;">(\$135.00)</td> </tr> </tbody> </table>	Deposit Account Name	Frommer Lawrence & Haug LLP	Deposit Account Number	50-0320	Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid	101	740	201	370	Utility filing fee	\$370.00	106	330	206	165	Design filing fee		107	510	207	255	Plant filing fee		108	740	208	370	Reissue filing fee		114	160	214	80	Provisional filing fee		SUBTOTAL (1)					\$370.00	Total Claims	35	-20** =	15	X	135.00	=	135.00	Ind. Claims		-3** =		X		=		Multiple Dependent				X		=		Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid	103	18	203	9	Claims in excess of 20		102	84	202	42	Independent claims in excess of 3		104	280	204	140	Multiple dependent claim, if not paid		109	84	209	42	** Reissue independent claims over original patent		110	18	210	9	** Reissue claims in excess of 20 and over original patent		107	510	207	255	Plant filing fee		SUBTOTAL (2)					(\$135.00)	<h3 style="text-align: center;">FEE CALCULATION</h3> <h4>3. ADDITIONAL FEES</h4> <table border="1" style="width: 100%; border-collapse: collapse;"> <thead> <tr> <th>Large Fee Code</th> <th>Entity Fee (\$)</th> <th>Small Fee Code</th> <th>Entity Fee (\$)</th> <th>Fee Description</th> <th>Fee Paid</th> </tr> </thead> <tbody> <tr><td>105</td><td>130</td><td>205</td><td>65</td><td>Surcharge - late filing fee or oath</td><td></td></tr> <tr><td>127</td><td>50</td><td>227</td><td>25</td><td>Surcharge - late provisional filing fee or Cover sheet</td><td></td></tr> <tr><td>139</td><td>130</td><td>139</td><td>130</td><td>Non-English specification</td><td></td></tr> <tr><td>147</td><td>2,520</td><td>147</td><td>2,520</td><td>For filing a request of reexamination</td><td></td></tr> <tr><td>112</td><td>920*</td><td>112</td><td>920*</td><td>Requesting publication of SIR prior to Examiner action</td><td></td></tr> <tr><td>113</td><td>1,840*</td><td>113</td><td>1,840*</td><td>Requesting publication of SIR after Examiner action</td><td></td></tr> <tr><td>115</td><td>110</td><td>215</td><td>55</td><td>Extension for reply within first month</td><td></td></tr> <tr><td>116</td><td>400</td><td>216</td><td>200</td><td>Extension for reply within second month</td><td></td></tr> <tr><td>117</td><td>920</td><td>217</td><td>460</td><td>Extension for reply within third month</td><td></td></tr> <tr><td>118</td><td>1,440</td><td>218</td><td>720</td><td>Extension for reply within fourth month</td><td></td></tr> <tr><td>128</td><td>1,960</td><td>228</td><td>980</td><td>Extension for reply within fifth month</td><td></td></tr> <tr><td>119</td><td>320</td><td>219</td><td>160</td><td>Notice of Appeal</td><td></td></tr> <tr><td>120</td><td>320</td><td>220</td><td>160</td><td>Filing a brief in support of an appeal</td><td></td></tr> <tr><td>121</td><td>280</td><td>221</td><td>140</td><td>Request for oral hearing</td><td></td></tr> <tr><td>138</td><td>1,510</td><td>138</td><td>1,510</td><td>Petition to institute a public use Proceeding</td><td></td></tr> <tr><td>140</td><td>110</td><td>240</td><td>55</td><td>Petition to revive - unavoidable</td><td></td></tr> <tr><td>141</td><td>1,280</td><td>241</td><td>640</td><td>Petition to revive- unintentional</td><td></td></tr> <tr><td>142</td><td>1,280</td><td>242</td><td>640</td><td>Utility issue fee (or reissue)</td><td></td></tr> <tr><td>143</td><td>460</td><td>243</td><td>230</td><td>Design issue fee</td><td></td></tr> <tr><td>144</td><td>620</td><td>244</td><td>310</td><td>Plant issue fee</td><td></td></tr> <tr><td>122</td><td>130</td><td>122</td><td>130</td><td>Petitions to the Commissioner</td><td></td></tr> <tr><td>123</td><td>50</td><td>123</td><td>50</td><td>Petitions related to provisional Applications</td><td></td></tr> <tr><td>126</td><td>180</td><td>126</td><td>180</td><td>Submission of Information Disclosure Statement</td><td></td></tr> <tr><td>581</td><td>40</td><td>581</td><td>40</td><td>Recording each patent assignment per property (times number of properties)</td><td></td></tr> <tr><td>146</td><td>740</td><td>246</td><td>370</td><td>Filing a submission after final rejection (37 CFR 1.129(a))</td><td></td></tr> <tr><td>149</td><td>740</td><td>249</td><td>370</td><td>For each additional invention to be examined (37 CFR 1.129(b))</td><td></td></tr> <tr><td colspan="5">Other fee (specify)</td><td></td></tr> <tr><td colspan="5">Other fee (specify)</td><td></td></tr> <tr> <td colspan="5" style="text-align: right;">SUBTOTAL (3)</td> <td style="text-align: right;">(\$)</td> </tr> </tbody> </table> <p style="font-size: small;">* Reduced by Basic Filing Fee</p>	Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid	105	130	205	65	Surcharge - late filing fee or oath		127	50	227	25	Surcharge - late provisional filing fee or Cover sheet		139	130	139	130	Non-English specification		147	2,520	147	2,520	For filing a request of reexamination		112	920*	112	920*	Requesting publication of SIR prior to Examiner action		113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action		115	110	215	55	Extension for reply within first month		116	400	216	200	Extension for reply within second month		117	920	217	460	Extension for reply within third month		118	1,440	218	720	Extension for reply within fourth month		128	1,960	228	980	Extension for reply within fifth month		119	320	219	160	Notice of Appeal		120	320	220	160	Filing a brief in support of an appeal		121	280	221	140	Request for oral hearing		138	1,510	138	1,510	Petition to institute a public use Proceeding		140	110	240	55	Petition to revive - unavoidable		141	1,280	241	640	Petition to revive- unintentional		142	1,280	242	640	Utility issue fee (or reissue)		143	460	243	230	Design issue fee		144	620	244	310	Plant issue fee		122	130	122	130	Petitions to the Commissioner		123	50	123	50	Petitions related to provisional Applications		126	180	126	180	Submission of Information Disclosure Statement		581	40	581	40	Recording each patent assignment per property (times number of properties)		146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))		149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))		Other fee (specify)						Other fee (specify)						SUBTOTAL (3)					(\$)
Deposit Account Name	Frommer Lawrence & Haug LLP																																																																																																																																																																																																																																																																																																										
Deposit Account Number	50-0320																																																																																																																																																																																																																																																																																																										
Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid																																																																																																																																																																																																																																																																																																						
101	740	201	370	Utility filing fee	\$370.00																																																																																																																																																																																																																																																																																																						
106	330	206	165	Design filing fee																																																																																																																																																																																																																																																																																																							
107	510	207	255	Plant filing fee																																																																																																																																																																																																																																																																																																							
108	740	208	370	Reissue filing fee																																																																																																																																																																																																																																																																																																							
114	160	214	80	Provisional filing fee																																																																																																																																																																																																																																																																																																							
SUBTOTAL (1)					\$370.00																																																																																																																																																																																																																																																																																																						
Total Claims	35	-20** =	15	X	135.00	=	135.00																																																																																																																																																																																																																																																																																																				
Ind. Claims		-3** =		X		=																																																																																																																																																																																																																																																																																																					
Multiple Dependent				X		=																																																																																																																																																																																																																																																																																																					
Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid																																																																																																																																																																																																																																																																																																						
103	18	203	9	Claims in excess of 20																																																																																																																																																																																																																																																																																																							
102	84	202	42	Independent claims in excess of 3																																																																																																																																																																																																																																																																																																							
104	280	204	140	Multiple dependent claim, if not paid																																																																																																																																																																																																																																																																																																							
109	84	209	42	** Reissue independent claims over original patent																																																																																																																																																																																																																																																																																																							
110	18	210	9	** Reissue claims in excess of 20 and over original patent																																																																																																																																																																																																																																																																																																							
107	510	207	255	Plant filing fee																																																																																																																																																																																																																																																																																																							
SUBTOTAL (2)					(\$135.00)																																																																																																																																																																																																																																																																																																						
Large Fee Code	Entity Fee (\$)	Small Fee Code	Entity Fee (\$)	Fee Description	Fee Paid																																																																																																																																																																																																																																																																																																						
105	130	205	65	Surcharge - late filing fee or oath																																																																																																																																																																																																																																																																																																							
127	50	227	25	Surcharge - late provisional filing fee or Cover sheet																																																																																																																																																																																																																																																																																																							
139	130	139	130	Non-English specification																																																																																																																																																																																																																																																																																																							
147	2,520	147	2,520	For filing a request of reexamination																																																																																																																																																																																																																																																																																																							
112	920*	112	920*	Requesting publication of SIR prior to Examiner action																																																																																																																																																																																																																																																																																																							
113	1,840*	113	1,840*	Requesting publication of SIR after Examiner action																																																																																																																																																																																																																																																																																																							
115	110	215	55	Extension for reply within first month																																																																																																																																																																																																																																																																																																							
116	400	216	200	Extension for reply within second month																																																																																																																																																																																																																																																																																																							
117	920	217	460	Extension for reply within third month																																																																																																																																																																																																																																																																																																							
118	1,440	218	720	Extension for reply within fourth month																																																																																																																																																																																																																																																																																																							
128	1,960	228	980	Extension for reply within fifth month																																																																																																																																																																																																																																																																																																							
119	320	219	160	Notice of Appeal																																																																																																																																																																																																																																																																																																							
120	320	220	160	Filing a brief in support of an appeal																																																																																																																																																																																																																																																																																																							
121	280	221	140	Request for oral hearing																																																																																																																																																																																																																																																																																																							
138	1,510	138	1,510	Petition to institute a public use Proceeding																																																																																																																																																																																																																																																																																																							
140	110	240	55	Petition to revive - unavoidable																																																																																																																																																																																																																																																																																																							
141	1,280	241	640	Petition to revive- unintentional																																																																																																																																																																																																																																																																																																							
142	1,280	242	640	Utility issue fee (or reissue)																																																																																																																																																																																																																																																																																																							
143	460	243	230	Design issue fee																																																																																																																																																																																																																																																																																																							
144	620	244	310	Plant issue fee																																																																																																																																																																																																																																																																																																							
122	130	122	130	Petitions to the Commissioner																																																																																																																																																																																																																																																																																																							
123	50	123	50	Petitions related to provisional Applications																																																																																																																																																																																																																																																																																																							
126	180	126	180	Submission of Information Disclosure Statement																																																																																																																																																																																																																																																																																																							
581	40	581	40	Recording each patent assignment per property (times number of properties)																																																																																																																																																																																																																																																																																																							
146	740	246	370	Filing a submission after final rejection (37 CFR 1.129(a))																																																																																																																																																																																																																																																																																																							
149	740	249	370	For each additional invention to be examined (37 CFR 1.129(b))																																																																																																																																																																																																																																																																																																							
Other fee (specify)																																																																																																																																																																																																																																																																																																											
Other fee (specify)																																																																																																																																																																																																																																																																																																											
SUBTOTAL (3)					(\$)																																																																																																																																																																																																																																																																																																						

SUBMITTED BY				Complete (if applicable)	
Typed or Printed Name		Susan K. Lehnhardt		Reg. Number	
Signature		<i>Susan Lehnhardt</i>		33,943	
		Date	Oct. 11, 2001	Deposit Account	50-0320

WARNING: Information on this form may become public. credit card information should not be included on this form.
Provide credit card information and authorization on PTO-2038.

CERTIFICATE OF MAILING BY EXPRESS MAIL

Applicant(s) : Gavril W. PASTERNAK, et al.
Serial No. : To Be Assigned (Divisional of Appln. Serial No. 09/844,111)
For : TOPICAL ANESTHETIC/OPIOID FORMULATIONS
AND USES THEREOF
Filed : CONCURRENT

745 Fifth Avenue, New York, NY 10151

Date of Deposit: October 11, 2001 via "Express Mail" # EL861104765US

I hereby certify that a Utility Patent Application and related documents for the above-referenced application are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to:

Assistant Commissioner for Patents
Box Patent Application
Washington, D.C. 20231

Charles B. Jackson

(Typed or printed name of person mailing paper or fee)

Charles B. Jackson

(Signature of person mailing paper or fee)